

## REMARKS

This responds to the Final Office Action mailed on January 4, 2006.

No claims are amended, claims 21 and 23-29 are canceled, and no claims are added; as a result, claims 1-20, 22, and 30 are now pending in this application.

### Revocation and Power of Attorney

A Revocation and Power of Attorney identifying this application by application number and filing date was filed with the U.S. Patent Office on July 21, 2005 (copy enclosed). Applicant respectfully requests that all future correspondence be sent to Applicant's representatives, **Customer No. 49845**, at the address indicated in the executed Revocation and Power of Attorney.

### §103 Rejection of the Claims

Claims 1-16, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Woolston (U.S. 6,202,051; hereinafter Woolston) in view of Hof et al. (eBay vs. Amazon.com, May 31, 1999, Business Week, pg.128; hereinafter Hof).

Applicant respectfully submits that claims 1-16 and 30 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitations:

*presenting, via a first computer system, both an auction purchase process and a fixed-price purchase process for purchase of an offering to a buyer; and*

*responsive to receipt of a bid from the buyer as part of the auction purchase process, removing the presentation of the fixed-price purchase process.*

The Final Office Action contends that the above limitations are obvious when combining Woolston and Hof. Specifically, the Final Office Action notes that Hof describes “adding fixed prices to their auctions.” With regard to adding fixed prices to auctions the Applicant notes that Hof describes the following:

“ebay is mulling fixed prices”

Hof, Page 2, paragraph 1.

“And eBay recently polled members on whether they’d like to see fixed – price auctions.”

Hof, Page 4, paragraph 3.

It’s [eBay] also mulling fixed – price auctions and dealer storefronts to offer a wider range of products and pricing choices.

Hof, Page 9, bottom of page.

The above quotes from Hof describe eBay as mulling or considering “fixed-price auctions.”

Applicant has carefully read Hof and believes the above mentioned quotes are the only quotes that mention both auctions and fixed pricing.

Claim 1 requires presenting an auction purchase process and a fixed-price purchase process and removing the presentation of the fixed-price purchase process in response to receiving a bid from a buyer. In contrast, the above quotes from Hof do not describe removing the presentation of a fixed-price purchase process in response to receiving a bid from a buyer; but rather, eBay as mulling fixed prices, polling members to see whether they would like fixed-price auctions, and mulling fixed-price auctions. Indeed, the Hof article, for the most part, compares the competitive strategies of eBay and Amazon (e.g., title, eBay vs. Amazon.com) and does not describe a presentation of an auction purchase process and a fixed-price purchase process, much less the **removal of the presentation of the fixed-price purchase process in response to receiving a bid from a buyer**.

The Final Office Action states that “Woolston shows both a fixed price market as well as an auction market available on a single interface.” Applicant notes that Figure 13 in Woolston is a diagram showing a user interface that may be presented to a posting terminal 700 user (Col. 15, lines 53-54). The user interface includes a full price field 962 and a reserve price field 958. Nevertheless, the user interface is described as allowing the **presentment of goods to market** (Col. 14, lines 61-63) and is not described as responding to a bid from a buyer as part of an auction purchase process by removing a presentation of the fixed-price purchase process, as required by claim 1.

The Final Office Action further states that Hof discloses contemplation of “fixed-price auctions.” Applicant has carefully read Hof and believes the only quotes that mention both auctions and fixed pricing are reproduced above. Applicant respectfully points out that the above quotes do not provide a description of a “fixed-price auction.” One may speculate as to the meaning of such a term. Indeed, the term “fixed price auction” is a contradiction and does not appear in the present application. Further, the term “fixed price auction” may be a misquotation by the author of Hof.

Hof therefore cannot be said to anticipate the above quoted limitation because Hof describes eBay as mulling fixed prices, polling members to see whether they would like fixed-price auctions, and mulling fixed-price auctions without providing a description of a “fixed-price auction” and claim 1 requires presenting an auction purchase process and a fixed-price purchase process and removing the presentation of the fixed-price purchase process in response to receiving a bid from a buyer.

The above remarks are also applicable to a consideration of independent claims 10 and 30.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-9 and 11-16 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Woolston in view of Hof as applied to claims 16 and 23 above, and further in view of eBay ([http://web.archive.org/web/\\*http://www.ebay.com](http://web.archive.org/web/*http://www.ebay.com), Date: 11/27/99, Category: Toys, Bean Bag Plush: Action Figures: General; hereinafter Webpage). Claims 17-19 depend on independent

claim 10 therefore the rejection of rejection of claims 17-19 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hess et al. (U.S. 6,058,417; hereinafter Hess) in view of Hof. The above remarks are applicable to a consideration of independent claim 20. Claims 21-22 depend on independent claim 20 therefore the rejection of claims 21-22 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Woolston in combination with Hof in combination with Webpage in combination with Hess does not teach or suggest each and every limitation of claims 1, 10, 20 and 30 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 - EXPEDITED PROCEDURE

Serial Number: 09/820,574

Filing Date: March 28, 2001

Title: METHOD AND SYSTEM TO ENABLE A FIXED PRICE PURCHASE WITHIN AN ONLINE AUCTION ENVIRONMENT

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Dk: 2043.040US1

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 3/6/2006

By



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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6<sup>th</sup> day of March, 2006.

Dawn R. Shaw

Name

Signature

